

REMARKS

The Applicant appreciates the thorough review of the application by the Examiner. Reconsideration and allowance are requested.

Claims 1-10, 15-17 and 20 stand rejected over prior art and remain pending in the Application.

Claims 1-10, 15-17 and 20 are patentable under 35 U.S.C. § 103(a) as being obvious over Krzyzanowski. (US 3,276,622) in view of Leopoldi (US 4,071,165).

MPEP §2141 states "Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case." (Emphasis in original) MPEP §2141 further states "Office policy is to follow Graham v. John Deere Co. in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquires enunciated therein as a background for determining obviousness are as follows: (A) Determining the scope and contents of the prior art; (B) Ascertaining the differences between the prior art and the claims in issue; (C) Resolving the level of ordinary skill in the pertinent art; and (D) Evaluating evidence of secondary considerations." It is respectfully submitted that the August 9, 2007 Office Action does not comply with Office policy at least in that it lacks a resolution of the level of ordinary skill in the pertinent art.

MPEP §2141 also states "When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to: (A) The claimed invention must be considered as a whole; (B) The

references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and (D) Reasonable expectation of success is the standard with which obviousness is determined."

MPEP §2141.02 also states "Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole." MPEP §2141.02 further states "In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." (Emphasis in original)

It is respectfully submitted that the Office Action of August 9, 2007, does not consider the prior art or references as a whole and does not consider the claimed invention as a whole, without the benefit of impermissible hindsight. Krzyzanowski teaches a dispensing carton that engages stacked articles and raises them out of the carton to be grasped and removed. (Col. 1, lines 9-15, 48-52) A top moveable member 17 is rotated counter-clockwise, revealing a top opening in a carton 10 and causing the flexible back end 18 of the member to slide across the top tissue 36 of interior tissue stack 35 (Fig. 3), catching on an edge 37 of the tissue and raising it out the top opening created in the carton 10 (Fig. 4, Fig. 5, Fig. 6).

In contrast, Leopoldi is a paper dispenser consisting of a tray on which a stack of paper can be laid and a retainer 17 with dispenser member 22 (Figs. 1-5). When the retainer 17 is pushed down it forces the dispensing member outward, which also pushed the paper outward so

that the end of a sheet of paper projects out beyond the edge of the tray (Fig. 4) for easy grasping and removal.

These are two completely different inventions that operate though different mechanisms. Krzyzanowski teaches a carton with a top opening full of a stack of tissues where the tissues are removed through the top opening by a member that catches on a creased portion of a tissue and raises it through the top opening for removal. Leopoldi teaches a tray with a stack of papers where a lever uses a frictional member to push the top sheet of paper over the edge of the tray. The only similarity is that they both dispense articles one at a time. There would have been no motivation or suggestion to one of ordinary skill in the art to modify Krzyzanowski with any of the teachings of Leopoldi.

The Examiner argues that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the dispenser of Krzyzanowski to include the articles contained in the dispenser to be paper strips... because the dispenser apparatus could be used to dispense a wide array of article." Applicant respectfully disagrees.

MPEP §2141.02 teaches "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." (Emphasis in original) Paper could not be used in the dispenser carton of Krzyzanowski because Krzyzanowski teaches catching a creased edge of a tissue or similar article with its member and raising it out of the top opening of the carton. Paper does not have a creased edge to be caught and could not be raised out of the carton. If a portion of the paper could somehow be raised out of the carton, the sheet of paper would be badly creased or torn as it was forced out of the small top opening, unlike tissue which is flexible and not easily deformable. When the references are

considered as a whole, they do not suggest the desirability and thus the obviousness of making the combination.

Similarly, with regard to the high friction surface, the Examiner argues that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the dispenser of Krzyzanowski to include... a friction surface at the tip of the extension as taught by Leopoldi because... the high friction surface would provide a better friction contact between the tip of the extension and the top most strip in the stack." Applicant respectfully disagrees. As clearly shown in Figure 4 of Krzyzanowski, frictional contact between the tip of the extension and the tissue is irrelevant. Krzyzanowski operates by inserting the member under an edge of the tissue and raising it out of the dispenser.

In fact, a frictional surface would render Krzyzanowski inoperable for its intended purpose. It is well established, that if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See MPEP§ 2143.01(V).

Krzyzanowski relies on a low friction extension to accomplish its purpose. The member slides across the articles with sufficient force to bend the member (Fig. 3), which causes the tip to slide under the creased edge of the tissue when it is rotated. If the member had a friction tip as in Leopoldi, instead of sliding freely across the tissues, the tip would catch on the articles and force them forwards against the front of the box, causing the tissues to crease and bunch up against the front of the carton and not to be dispensed as desired. A high friction tip as taught by Leopoldi could not slide under the creased edge of a tissue as required by Krzyzanowski.

Again, when the references are considered as a whole, they do not suggest the desirability and thus the obviousness of making the combination. Without a motivation for combining the references, there is no prima facie case of unpatentability and the claims must be allowed. The present invention, taken as a whole, would not be obvious from the references, taken as a whole. Only by relying on impermissible hindsight motivation found in the present Application could the references be combined to come up with the claimed invention.

For at least that reason, the rejection of Claim 1 under 35 U.S.C. 103(a) over Krzyzanowski in view of Leopoldi is improper and should be withdrawn. Claims 2-10, 15-17, and 20 depend from patentable Claim 1 and add further patentable limitations. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

In addition to lacking any suggestion or motivation for combination, Krzyzanowski and Leopoldi, alone or in combination, fail to teach or suggest all the claim limitations of Claims 2-10, 15-17, and 20. Examples follow.

Claim 4 adds that a friction side is found on one side of the extension and not the other, not found in Krzyzanowski or Leopoldi. The Examiner apparently agrees (Office Action, Page 4) but argues that "It would have been obvious... to modify the dispenser... such that the friction

surface is disposed at the bottom side of the member... because manufacturing the dispenser would be easier and more cost effective."

Applicant cannot agree. Applicant traverses the Examiner's holding of obviousness without citing to prior art. The use of a friction coating on one side of a member but not the other is not obvious from the prior art at least because the use of that element is the invention of the Applicant and because neither reference would benefit from such a modification. Applicant requests that the Examiner produce some evidence of obviousness or withdraw the rejection.

Furthermore, the Examiner's stated motivation is not found in the prior art and is conclusory rather than reasoned. How can the Examiner know, without even looking to the prior art, that manufacturing the dispenser would be easier and more cost effective if a friction coating was on only one side of the member? That element could easily make the manufacturing process more difficult by eliminating cost-effective means of conveying the friction tip, such as complete coating.

Claim 8 adds that a top strip in the stack slides along a next adjacent strip outward through the opening when the lever is moved. Krzyzanowski does not teach or suggest this feature. The Examiner has not suggested otherwise. In Krzyzanowski, the tissues do not slide across each other, but are raised straight up through a top opening. The tissues are too high-friction to slide over one another and in any case the opening in the carton does not extend all the way across the front or all the way to the bottom, making it impossible to slide the tissues along each other and outward through an opening. For these same reasons, it would be impossible to modify Krzyzanowski with the teachings of any other reference that teaches this element. If the Examiner disagrees, Applicant respectfully requests an explanation of that disagreement.

Furthermore, the arguments of the Response of July 20, 2007 are repeated and incorporated by reference. For at least the above reasons, the rejection of Claims 1-10, 15-17, and 20 under 35 U.S.C. 103(a) is improper and should be withdrawn. The invention, as claimed is new and unobvious.

CONCLUSION

Reconsideration and allowance are respectfully requested.

Respectfully,



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